

29. (Original) The composition according to claim 2 formulated as a hair shampoo, a body cleaner or a hand cleanser.
30. (Previously added) The composition according to claim 2 wherein said low density oily material is a difatty ester selected from the group consisting of Jojoba oil, oleyl oleate, oleyl erucate and mixtures, thereof.

#### **REMARKS**

After entering the instant amendment, claims 1-3 and 5-30 are pending in the present application, claim 4 having been previously cancelled and its subject matter incorporated into amended claim 2 and claim 30 having been previously added. Claims 11, 12 and 15 have been amended to address minor formalistic issues. Applicants believe that the instant application is now in condition for allowance. Support for the amendments to the claims can be found throughout the original specification and claims.

The Examiner has rejected previously filed claims 1-30 as failing to comply with the written description requirement as well as being anticipated under 35 U.S.C. §102 by Fowler, et al., U.S. no. 5,635,469 ("Fowler"). Applicants shall deal with each of these rejections in the sections which are presented hereinbelow.

#### **The New Matter Rejection**

The Examiner makes a new matter rejection under 35 U.S.C. §112, first paragraph of claims 1-30 as failing to comply with the written description requirement. In particular, the Examiner contends that the inclusion in the claims of the terms at least two and separate liquid phases upon setting is new matter. In addition, the Examiner indicates that there is no support in the original specification for the term "fourth distinct and separate phase". The Examiner requires that Applicants specifically point out support for these terms in amending the claims.

Applicants respectfully traverse the Examiner's rejection that the previously amended claims presented new matter. Applicants respectfully submit that the originally filed

specification is *replete* with support for the previously filed amendment to the claims. Support for the amendment to the previously filed claims and in particular, to the fact that the at least two of the phases are separate, distinct liquid phases may be found in the specification at page 2, the first sentence under the **Object of the Invention**, the first six lines on page 3, the first line under **Summary of the Invention**, the remainder of page 3, page 4, page 5, and in particular, the first full paragraph, page 6, in particular the second and third full paragraphs, page 8, in particular under the definition of "phase", page 9, the first two lines directed to the definition of "settling", page 9, the fourth full paragraph, the bottom paragraph of page 9, page 11, third full paragraph, page 11, bottom and page 12, top, page 13, the first full paragraph, and page 13, second full paragraph, the first 5 lines and the last 5 lines, page 14, the examples set forth on pages 16-20 and in the originally filed claims and in particular, original claim 1 and claim 4, which is dependent on claim 1. Indeed, it is respectfully submitted that the original specification is *replete* with support for the terms which have been included in the amended claims. Applicants respectfully request the Examiner to withdraw this rejection inasmuch as it cannot be credibly maintained given the support in the specification of the amended claims.

#### The §102 Rejection

Turning now to the Examiner's rejection of the previously filed claims under 35 U.S.C. §102 as being anticipated by Fowler, Applicants respectfully traverse the Examiner's rejection. In particular, the Examiner has rejected originally filed claims 1-2, 4-5, 8-14, 16-21, 24-26 and 28-29 under 35 U.S.C. §102(b) as being anticipated by Fowler essentially arguing that Fowler inherently teaches the presently claimed compositions for the reasons which are stated in paragraph 2 of the office action. Applicants respectfully traverse the Examiner's rejection.

The present invention relates to certain compositions which are multiple phase surfactant compositions comprising at least two distinct and separate liquid phases upon settling, wherein the compositions comprise a first or lower high density emollient/conditioning layer comprising at least one high density aromatic ester emollient or conditioning agent having a specific gravity of greater than 1.00 and at least one additional layer comprising a surfactant solution having a specific gravity which is less than the specific gravity of the high density layer. The present

invention is directed to compositions which exhibit activity as surfactant compositions having emollient characteristics and a pleasant two-layered liquid presentation. Thus, the present invention relates to compositions which exhibit excellent surfactant and emollient/conditioning characteristics with a superior presentation, that presentation being the separation of the product into at least two distinct liquid layers. Contrary to the Examiner's contention, Fowler does not anticipate the present invention, either literally or inherently. It is respectfully submitted that the Examiner has no basis upon which to maintain the inherency rejection, other than speculation grounded in *hindsight*, and consequently, Applicants respectfully request the Examiner to withdraw this rejection.

Fowler teaches foaming cleansing products which can contain, *inter alia*, surfactants as well as emollients/conditioners. However, Fowler does not disclose compositions which are in two distinct liquid layers. Fowler clearly does not specifically or literally disclose such compositions and contrary to the Examiner's contention, there is no inherent disclosure of the present invention.

With respect to the Examiner's argument at Fowler inherently anticipates the present invention, it is respectfully submitted that the Examiner has not made out a cogent case that the present invention is inherent in the compositions of Fowler.

***The Doctrine of Inherency Relied Upon by the Examiner***

In order to find a claimed invention invalid under the doctrine of inherency, the Examiner must show that one of ordinary skill following the teachings of the reference must necessarily, inevitably and always produce every element of the claimed invention. Mere possibilities, probabilities or accidents are not sufficient for making out a proper case under the doctrine of inherency. The result must be *absolutely certain*. See In re Robertson, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999); Glaxo, Inc. v. Novopharm, Ltd., 52 F.3d 1043, 34 U.S.P.Q.2d 1565 (Fed. Cir. 1995), *cert. denied*, 116 S.Ct. 516 (1995); Electro Medical Systems, S.A. v. Cooper Life System, Inc., 34 F.3d 1048, 32 U.S.P.Q.2d (Fed. Cir. 1994); Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1269, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir.

1991); W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553-54, 220 U.S.P.Q. 303, 313-14 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 325-26 (C.C.P.A 1981); and Phillips Petroleum Co. v. U.S. Steel Corp., 673 F.Supp. 1278, 1295 n.12, 6 U.S.P.Q.2d 1065, 1076-77 n.12 (D.Del. 1987), among others. It is respectfully submitted that the Examiner has asserted a legal doctrine which has been misapplied to the facts of the instant invention. There is simply no possible way that the Examiner's inherency argument may be cogently maintained in the face of the teachings of Fowler and the claims of the present invention.

The Examiner cannot cite *any specific composition which* is disclosed in Fowler which meets the limitations of the claimed invention. Rather, the Examiner relies on generic disclosures in Fowler (see paragraph 2 of the October 17, 2003 office action) to argue that one of ordinary skill will essentially "cherry pick" the correct components as claimed in the present application in order to produce a composition as claimed, which is desirably characterized by exhibiting at least two distinct and separate liquid phases. While it is true that one of ordinary skill might be able to pick the proper components of the present invention out of the large number of embodiments which are disclosed in Fowler, it is respectfully submitted that that possibility only occurs as a consequence of the person of ordinary skill having been shown the present invention. Without the teachings of the present invention, the likelihood that one of ordinary skill will reliably and consistently produce the present invention does not exist. *Thus, not only does the Examiner make a rejection based upon inherency which does not exist, but relies on a hindsight construction of the present invention to make that rejection!*

It is noted in paragraph 4 of the October 17 office action that the Examiner cites Examples II-IV as inherently anticipating the present invention. Those compositions cannot possibly anticipate the present invention inasmuch as the present invention is directed to compositions as claimed, which contain at least one high density aromatic ester emollient and a surfactant. The Examiner cites examples which cannot meet the limitations of the claims. In particular, the emollients which the Examiner cites, sodium isostearyl lactylate or lauryl pidolate are not high density aromatic esters as that term has been defined in the specification at page 7. Indeed, these compounds are not even aromatic emollients, let alone high density

aromatic emollients which form a first or lower layer, as is required by the claims of the instant invention. Consequently, it cannot be said that Fowler somehow anticipates the present invention *inherently* when the Examiner cites components in examples which are not claimed. Thus, the Examiner has not and cannot cite a single, specifically disclosed composition of Fowler which *necessarily, always and inevitably* meets the limitations of the claims of the present invention. Because the Examiner cannot cite any composition which meets the requirements of the doctrine of inherency as established by relevant caselaw, the Examiner has failed to make out a cogent case that the present invention is unpatentable. The mere possibility that one of ordinary skill might *accidentally* produce the present invention using the components generically disclosed in Fowler does not obviate the deficiencies of the rejection based upon inherency. As such, the present invention is clearly novel over the cited art.

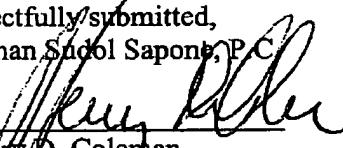
Moreover, nowhere in Fowler is there a disclosure or even an oblique mention of different phases, phase separation, layering, differential phase coloration or component specific gravities, i.e., densities. In short, there is nothing in Fowler which even remotely suggests that Fowler provided a composition or a teaching which gives rise to the present invention. It is respectfully submitted that the Examiner has failed to make out a case that the present invention is inherently anticipated by the present invention.

For all of the above reasons, it is respectfully submitted that the present application is now in condition for allowance and such action is earnestly solicited. No claim has been added or cancelled. No fee is therefore due for the presentation of this amendment. A notice of appeal is enclosed as is a check in the amount of \$165.00. If the Examiner decides that any additional fee is required, or that any credit is due, the Commissioner is authorized to charge any such fee or credit any such overpayment to deposit account 04-0838.

An indication of any charge made to the authorized Deposit Account is respectfully requested at the time of the issuance of a further office action, so that the charge may be accurately tracked.

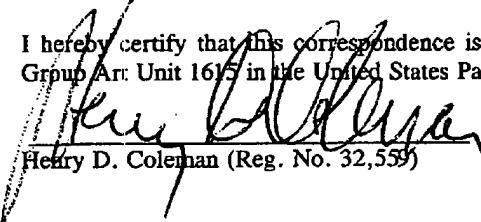
Dated: 1/2/04

Respectfully submitted,  
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**CERTIFICATE OF FACSIMILE**

I hereby certify that this correspondence is being sent by facsimile to Examiner J. Venkat in Group Art Unit 1615 in the United States Patent and Trademark Office on January 2, 2004.

  
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